



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/538,342

06/05/2006

Christian R. Thomas

11987-00036-US

1568

23416

7590

06/09/2009

CONNOLLY BOVE LODGE & HUTZ, LLP

P O BOX 2207

WILMINGTON, DE 19899

EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

06/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,342	Applicant(s) THOMAS, CHRISTIAN R.	
	Examiner REBECCA L. ANDERSON	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/22/08, 6/10/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-16 are currently pending in the instant application. Claims 1-11, 13 and 14 are withdrawn from consideration as being for non-elected subject matter. Claims 12, 15 and 16 are rejected.

Election/Restrictions

Applicant's election with traverse of Group IX, claims 12, 15 and 16 drawn to the compounds of the formula (X) in the reply filed on 22 May 2009 is acknowledged. The traversal is on the ground(s) that the claims all relate to a single inventive concept. This argument is not persuasive as the formula (X) is not a special technical feature as can be seen by the following art rejection. Applicants also argue that because there was no lack of unity rejection during the international phase by the International Searching Authority, such a restriction is unjustified in the national phase of the present application. This argument is not persuasive as according to MPEP 1893.03(d) and 37 CFR 1.499, if the examiner finds that a national stage application lacks unity of invention the examiner may require the applicant to elect the invention to which the claims shall be restricted at any time before the final action at the discretion of the examiner. Lastly, Applicants argue that alternatively, at least Groups I, IV, V, VI, VII, VIII and IX should be examined together as they relate to the compound of formula (X), its methods of use and its process of preparation. This argument is not persuasive as previously stated, the formula (X) is not a special technical feature as seen by the art rejection below and therefore the claims do not relate to a single inventive concept as the claims lack a special technical feature.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Claims 12, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/47919.

Determining the scope and contents of the prior art

The prior art discloses the compound 5-chloro-N-(2-hydroxy-3-{{4-(3-oxo-4-morpholinyl)phenyl}amino}propyl)-2-thiophenecarboxamide on page 91, example 63.

Page 31 discloses that compounds may exist in stereoisomeric forms and can be separated in a known manner into the stereoisomerically uniform components.

Furthermore, page 17 discloses the preference to a particular final product with specific stereochemistry.

Ascertaining the differences between the prior art and the claims at issue

The difference between the prior art and the claims at issue is that the prior art compound of example 63 does not state the specific stereochemistry.

Resolving the level of ordinary skill in the pertinent art

However, minus a showing of unobvious results, it would have been obvious to prepare stereoisomers of the compound of example 63 when faced with the preferred final product of page 17 and the statement that stereoisomers may exist and can be separated in a known manner. Additionally, A stereoisomer is not patentable over its known racemic mixture unless it possessess unexpected properties not possessed by the racemic mixture. In re Anthony, 162 USPQ 594, 596 (1969) and In re Adamson, 125 USPQ 233, 234 (1960).

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

5 June 2009

Rebecca Anderson
Primary Examiner
Art Unit 1626, Group 1620
Technology Center 1600